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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,651	02/06/2004	David M. Oliver	RSW920030179US1	8803
23307 7590 01/16/2008 SYNNESTVEDT & LECHNER, LLP 1101 MARKET STREET 26TH FLOOR PHILADELPHIA, PA 19107-2950			EXAMINER SCUDERI, PHILIP S	
			ART UNIT 2153	PAPER NUMBER
			MAIL DATE 01/16/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/774,651	<b>Applicant(s)</b> OLIVER ET AL.	
	<b>Examiner</b> Philip S. Scuderi	<b>Art Unit</b> 2153	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,3-8,10-15,17-22 and 24-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-8,10-15,17-22 and 24-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Arguments*

#### I. MSN Messenger Protocol as described by hypothetical.org

Applicant's arguments filed 11/21/2007 (herein "Remarks") in regards to the rejections using MSN ("MSN Instant Messenger Protocol", 23-27 April 2002, printed from hypothetical.org), which describes the MSN Protocol, have been fully considered but they are not persuasive.

1. Applicant argues that "MSN provides no basis for including interaction with an outside application" (see Remarks at pp. 10).

This argument is not deemed persuasive for the following reasons.

MSN teaches receiving notification messages as detailed on page 4 of the "connecting.php" page, reproduced as follows:

#### Other Server Messages

Besides the two initial messages that are received when logging in, the server can also send other types of messages during the session. I have found two of these so far: text/x-msmsgsemailnotification and text/x-msmsgsactivemailnotification. The first one notifies you when a new email has been received. The second notifies you when an email has been deleted (or maybe something else also). Below is an example of a new email being received.

```
MSG          Hotmail          Hotmail          340
MIME-Version:                               1.0
Content-Type:          text/x-msmsgsemailnotification;
charset=UTF-8

From:          Mike          Mintz
Message-URL:          /cgi-
bin/getmsg?msg=MSG1029401739.3&start=1610592&len=402&curm
box=ACTIVE
Post-URL:
```

```
https://lc1.law13.hotmail.passport.com/ppsecure/domesseng
erlogin/EN
Subject: Hi
Dest-Folder: ACTIVE
From-Addr: example@passport.com
id: 2
```

Below is an example of when I erase a message in my inbox.

```
MSG Hotmail Hotmail 145
MIME-Version: 1.0
Content-Type: text/x-msmsgsactivemailnotification;
charset=UTF-8

Src-Folder: ACTIVE
Dest-Folder: trASH
Message-Delta: 1
```

The "Post-URL" and "Message-URL" parameters shown above clearly suggest to one of ordinary skill in the art that the email message associated with the notification can be accessed using these parameters.

For example, one of ordinary skill in the art would appreciate that the email message from "Mike Mintz" can be accessed at the URL "https://lc1.law13.hotmail.passport.com/ppsecure/domessengerlogin/EN/cgi-bin/getmsg?msg=MSG1029401739.3&start=1610592&len=402&curmbox=ACTIVE."

2. Applicant argues that "[i]t would extend beyond the capabilities of one of ordinary skill in the art to reprogram MSN to include an automatic call to a browser program."

The position that initiating a call to a browser to is beyond the capabilities of one of ordinary skill in the art strains credulity. Programmatically initiating a call to a browser has been overwhelmingly well known in the art well before applicant's effective filing date. For example, the article "Launch a PC's default browser" enclosed with this action (dated prior to 7/20/2002, see page 2) describes ways to programmatically initiate a browser. As applicant is no doubt aware, "[a]

person of ordinary skill is also a person of ordinary creativity, not an automaton." KSR Int'l v. Teleflex, Inc., 127 S. Ct. 1727, 1742, 82 USPQ2d at 1397 (2007).

## II. Admitted Prior Art and U.S. Patent No. 7,024,209 to Gress et al.

Applicant's arguments filed 11/21/2007 (herein "Remarks") in regards to the rejections using the Gress reference (U.S. Patent No. 7,024,209) have been fully considered but they are not persuasive.

1. Applicant argues that Gress "provides no teaching or disclosure of initiating an action at a non-SMS device in response to a SIA message."

This argument is not deemed persuasive for the following reasons.

Gress does not need to teach or disclose "initating an action at a non-SMS device in response to a SIA message" because the rejection at issue is not in view of Gress alone. The claims were rejected over the Admitted Prior Art (see paragraphs 2-6 of the specification, herein "APA") in view of Gress.

Moreover, the APA as combined with Gress renders "initiating an action at a non-SMS device in response to a SIA message" obvious under section 103 for the following reasons.

The APA describes essentially the same system as the present invention except for the fact that the device is a SMS device such as a cell phone (see Spec. at paragraph 2). The SMS device receives an "alert message" indicating that a new email has arrived and the user "takes action to connect to the enterprise server to download and read the email" (see id., with emphasis added)

The only apparent difference between the APA and the claimed invention is that the claims specify that the device is a non-SMS device.

Gress teaches a system for converting SMS messages into a unified format and sending the messages to non-SMS devices. For example, in figures 1 and 2, Gress shows a unified messaging system (20) that receives SMS messages and converts them into, for example, email messages (40).

The examiner's position is that it would have been obvious to one of ordinary skill in the art to utilize Gress' system to receive the SIA activation messages described in the APA because Gress' system provides advantages such as enabling non-SMS type devices to access SMS messages and fulfilling the need for a unified messaging system (see Gress, at abstract, col. 2, ll. 1-14).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1, 3-8, 10-15, 17-22, and 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over MSN ("MSN Instant Messenger Protocol", 23-27 April 2002, printed from hypothetic.org).**

MSN describes the MSN Messenger protocol. The MSN Messenger Protocol uses email notifications as detailed on page 4 of the "connecting.php" page. The most relevant section of that page is reproduced as follows:

#### **Other Server Messages**

Besides the two initial messages that are received when logging in, the server can also send other types of messages during the session. I have found two of these so far: text/x-

msmsgsemailnotification and text/x-  
msmsgactivemailnotification. The first one notifies you when  
a new email has been received. The second notifies you when  
an email has been deleted (or maybe something else also).  
Below is an example of a new email being received.

```
MSG           Hotmail           Hotmail           340
MIME-Version:                               1.0
Content-Type:           text/x-msmsgsemailnotification;
charset=UTF-8

From:           Mike           Mintz
Message-URL:           /cgi-
bin/getmsg?msg=MSG1029401739.3&start=1610592&len=402&curm
box=ACTIVE
Post-URL:
https://lcl1.law13.hotmail.passport.com/ppsecure/domesseng
erlogin/EN
Subject:           Hi
Dest-Folder:           ACTIVE
From-Addr:           example@passport.com
id: 2
```

Below is an example of when I erase a message in my inbox.

```
MSG           Hotmail           Hotmail           145
MIME-Version:                               1.0
Content-Type:           text/x-msmsgactivemailnotification;
charset=UTF-8

Src-Folder:           ACTIVE
Dest-Folder:           trASH
Message-Delta: 1
```

Claims 1, 8, and 15 are directed to a method, system, and product for activating a non-SMS device connectable to an IP-based network, comprising the steps of, means for, and code for:

- sending an activation message to said non-SMS device over an IP-based messaging protocol;
- determining whether said activation message contains a server initiated action (SIA) message;
- and
- if said activation method contains an SIA message, configuring said non-SMS device to initiate an action contained in said SIA message.

The email notification message shown above is clearly an "activation message" that "contains a server initiated action (SIA) message."

1. MSN does not expressly disclose that the inherent device that receives the message is a "non-SMS device."

However, nowhere does MSN teach or suggest that the protocol is in any way limited to SMS devices. It would have been obvious to one of ordinary skill in the art to use the MSN protocol on a well-known non-SMS device such as a personal computer. The motivation for doing so would have been to utilize any of the advantages of the MSN protocol such as the ability to chat with other users and receive email notifications.

2. MSN does not expressly disclose "determining" whether received messages "contain a server initiated action (SIA)."

MSN discloses that the recipient device receives various different types of messages such as profile messages with Content-Type field of "text/x-msmsgsprofile" and email notification messages with Content-Type field of "text/x-msmsgsemailnotification" (see "connecting.php" at pp. 3-4).

This "determining" step appears to be inherent because if the recipient does not determine the type of message then the message cannot be processed accordingly. Moreover, even if there is some reason unbeknownst to the examiner that this step is not inherent, it would clearly have been obvious to perform this determining in order to process these messages according to their content type.



3. MSN does not expressly disclose, if the activation message contains an SIA message, configuring the receiving device to “initiate an action contained in the SIA message.”

The activation message corresponds to the email notification. The claimed “action” can be merely opening a browser using the “Message-URL” and “Post-URL” specified in the email notification.

Thus, “configuring” the device to initiate an action merely amounts to installing a browser on the device. It would have been obvious to one of ordinary skill in the art to install such a browser so that the user could view the email corresponding to email notifications.

As to claims 4, 11, and 18, MSN teaches that the IP-based messaging protocol comprises a chat protocol (MSN Instant Messenger Protocol) [see “messaging.php”, pages 5-6, which shows users chatting with each other].

As to claims 3, 7, 10, 14, 17, and 21, MSN teaches that the activation message (email notification message) further includes an initiation command (Message-URL and Post-URL) [see “connecting.php”, page 4].

One of ordinary skill in the art would appreciate that the initiation command (Message-URL and Post-URL) are clearly intended to initiate access an email message (the email from Mike Mintz) [see “connecting.php”, page 4].

MSN does not expressly disclose that the client receiving the command (Message-URL and Post-URL) initiates the command (Message-URL and Post-URL) to access the email message (the email from Mike Mintz), as set forth in claims 3 and 10. Also, MSN does not disclose launching of a

program on the non-SMS device to download email via the IP-based network, as set forth in claims 7 and 14.

It would have been obvious to one of ordinary skill in the art to initiate the command (Message-URL and Post-URL) to access the email message (the email from Mike Mintz) [see “connecting.php”, page 4] using a well-known browser program such as Internet Explorer. The motivation for doing so would have been to access the contents of the email message.

As to claims 5, 6, 12, 13, 19, and 20, MSN does not expressly disclose that the non-SMS device client provides an alert or indication that there is a new email available over the IP-based network.

Providing the command (Message-URL and Post-URL) to a well-known browser program such as Internet Explorer, as detailed above, is an indication to the browser and/or the user that there is email available for download.

It would have been obvious to one of ordinary skill in the art provide the command (Message-URL and Post-URL) to a well-known browser program such as Internet Explorer. The motivation for doing so would have been to access the contents of the email message.

As to claims 22 and 26, MSN teaches receiving messages containing a Content-Type field that identifies the type of message, wherein the type of message can be an SIA chat message (an email notification) (text/x-msmsgsemailnotification) or a textual message from another user (text/plain) [see “messaging.php”, pages 5-6; “connecting.php”, page 4].

1. MSN does not appear to expressly disclose identifying the SIA chat messages (email notification messages). One of ordinary skill in the art would readily recognize that the purpose of the Content-Type field is to enable the client to identify the type of content being received. It would have been obvious to one of ordinary skill in the art to identify the SIA chat messages (the email notification message) in order to properly process the incoming message content.
2. MSN does not expressly disclose blocking display of an SIA chat message (an email notification message). But, one of ordinary skill in the art would readily recognize that the SIA chat messages (email notifications) are not intended to be displayed because the textual messages that are intended to be displayed have a Content-Type field value set to "text/plain" [see "messaging.php", pages 5-6]. It would have been obvious to one of ordinary skill in the art to block standard display of the SIA chat messages (email notification messages) to comply with the intended use of the protocol.
3. MSN teaches that there are instructions (Message-URL and Post-URL) contained in said SIA chat messages (email notifications) [see "connecting.php", page 4]. But, MSN does not expressly disclose executing these instructions. One of ordinary skill in the art would readily recognize that the instructions (Message-URL and Post-URL) were intended to retrieve an associated email. It would have been obvious to one of ordinary skill in the art to execute the instructions (Message-URL and Post-URL) using a known browser to retrieve the email.
4. MSN does not expressly state that the client is a non-SMS device. However, nowhere does MSN teach or suggest that the protocol is in any way limited to SMS devices. It would have been obvious to one of ordinary skill in the art to use the MSN protocol on a well-known non-SMS device such as a personal computer. The motivation for doing so would have been to utilize any of

the advantages of the MSN protocol such as the ability to chat with other users and receive new email notifications.

As to claims 24 and 25, executing the instructions (Message-URL and Post-URL) using a browser is an action that alerts that indicates receipt of the email by the server and automatically connects the non-SMS device to the server.

**Claims 1, 3-8, 10-15, 17-22, and 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over APA (the Admitted Prior Art in the Background section of the Specification) in view of Gress (U.S. Patent No. 7,024,209).**

The APA admits that substantial claimed features such as notifying an SMS device of the arrival of a new email by sending an SIA activation message to the device, waking-up the device, and downloading the email on the device were well known in the art [see Specification, paragraphs 2-6]. The only apparent difference between the APA and these claims is that the claims specify that the device is a non-SMS device.

Gress teaches a system for converting SMS messages into a unified format and sending the messages to non-SMS devices [see Gress, abstract]. It would have been obvious to one of ordinary skill in the art to utilize Gress' system to receive the SIA activation message and retrieve the email accordingly because Gress' system provides advantages such as enabling non-SMS type devices to access SMS messages and fulfilling the need for a unified messaging system [see Gress, abstract, col. 2, ll. 1-14].

*Conclusion*

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip S. Scuderi whose telephone number is (571) 272-5865. The examiner can normally be reached on Monday-Friday 9:00 am - 5:30 pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton B. Burgess can be reached on (571) 272-3949. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/Philip S Scuderi/



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